

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Curt Thies
Serial No. : 10/769,210
Filed : January 30, 2004
Title : BEADING

Art Unit : 1713
Examiner : Kelechi C. Egwim
Conf. No. : 7576

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Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO THE DIRECTOR FROM REQUIREMENT FOR RESTRICTION

Under the provisions of 37 C.F.R. § 1.144 applicant respectfully petitions the Director to review and withdraw the traversed requirement for restriction made final in the office action dated May 2, 2007.

The 14 claims segregated by the Examiner into six groups for the first time following our Notice of Appeal and Brief on Appeal are:

1. Polymer bead of dry bead structure incorporating a diluent that is highly water-soluble characterized by swelling rapidly when placed in contact with aqueous media to form a water-swollen gel bead.
2. Polymer beads in accordance with claim 1 that are a dry-free-flow powder.
3. A method of making the beads of claim 1 by water-in-oil process.
4. The method of making the beads of claim 1 by the droplet extrusion method.
5. Agarose-dextrose beads made by the method of claim 3.
6. Gelatin-dextrose beads made by the method of claim 3.
7. Agarose-maltodextrin beads made by the method of claim 3.
8. Agarose-dextran beads made by the method of claim 3.
9. Agarose-Poly (ethylene glycol) beads made by the method of claim 3.
10. Agarose-Poly (ethylene glycol) beads made by the method of claim 4.

11. The method of using the beads of claim 1 in accordance with transporting water-swollen gel beads through an animal circulatory system.

12. The method of using the beads of claim 1 in accordance with transporting water-swollen gel beads containing a biological active agent through an animal circulatory system.

13. The method of using the beads of claim 1 in accordance with absorbing a finite amount of biological media at the point they are placed in an animal to serve as a hemostat to reduce hemorrhaging.

14. The method of using the beads of claim 1 in accordance with carrying a well defined amount of desired material into a defined small volume element.

M.P.E.P. 803 provides, "If the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions."

Manifestly, search and examination of all the claims in this application can be made without serious burden because in fact all 14 claims were searched and examined in this application, and the requirement for restriction was not made until after applicant filed his Notice of Appeal and Appeal Brief. Furthermore, all the claims are dependent upon elected claim 1, and prior art related to claim 1 is likely to disclose subject matter which must be searched in connection with examining claims in each of the groups.

35 U.S.C. § 121 reads, "If two or more independent and distinct invention are claimed in one application, the Director may require the application to be restricted to one of the inventions." Thus, restriction is proper only if the inventions are "independent and distinct."

The predecessor court of the Federal Circuit Court of Appeals in a decision binding upon the Office recognized that "independent and distinct" means independent and distinct.

In re Weber, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334, 336 (C.C.P.A. 1978).

We take this occasion to explain what precedents are considered binding in proceedings in the Patent and Trademark Office (PTO). Where the Court of Appeals for the Federal Circuit has addressed a point of law in a published opinion, the Federal Circuit's decision is controlling. Similarly controlling are decisions considered to be binding precedent by the Federal Circuit, i.e., decisions

of the former Court of Claims and the former Court of Customs and Patent Appeals, as well as the former Customs Court. See *South Corp. v. United States*, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982)(in banc); *Bar Zell Expeditors, Inc. v. United States*, 698 F.2d 1210, 1211 n. 4 (Fed. Cir. 1983). In those relatively rare cases where the Federal Circuit has not addressed an issue, but there is "authorized published" Board precedent, that published Board precedent is binding on panels of the Board and Examiners in the Patent Examining Corps. *Ex parte Holt*, 19 U.S.P.Q. 2d 1211, 1214 (BPA&I 1991).

M.P.E.P. 802.01 headed "Meaning of 'Independent' and 'Distinct' reads as follows:

I. INDEPENDENT

The term "independent" (i.e., >unrelated<) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions. See also MPEP § 806.06 and § 808.01.

II. >RELATED BUT < DISTINCT

Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g. function or method of use), or effect. Examples of related inventions include combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc. In this definition the term related is used as an alternative for dependent inventions.

Related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (combination and subcombination) and § 806.05 (j) (related products or related processes) for examples of when a two-way test is required for distinctness.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended.

M.P.E.P. 803.01 provides, "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE

WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION."

In a decision dated June 23, 1977, on a petition filed June 13, 1977, Group 1210 Director Alfred L. Leavitt in granting the petition to withdraw the requirement for restriction said:

Current Office policy is not to require restriction between related inventions when no substantial burden is involved in the examination of all claims in a single application.

And in a decision dated 3 December 1993 on a petition filed March 12, 1993, Group 1100 Deputy Director John Doyle said:

Restriction was required between (I)method for epitaxial deposition and (II)epitaxially deposited product (Paper No. 4). However, the examiner failed to present any convincing basis for the holding that the inventions as above grouped are distinct. The claimed inventions must be independent or distinct, and the examiner "must provide reasons and/or examples to support conclusions . . .". Further, the field of search for the alleged distinct inventions is seen to be coextensive, hence, no serious burden is seen to be incurred by examination of all pending claims. MPEP 803 under "Criteria For Restriction Between Patentably Distinct Inventions". The Petition is GRANTED.

In traversing the requirement for restriction, if the requirement for restriction were repeated, the Examiner was respectfully requested to rule that the claims in each group are PATENTABLE (novel and unobvious) OVER EACH OTHER and explain why all the claims cannot be examined without serious burden. The Examiner did not and cannot comply with this request.

Accordingly, withdrawal of the requirement for restriction is respectfully requested.

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Respectfully submitted,
FISH & RICHARDSON, P.C.

25 July 2007
Date: _____

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